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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
LIH-14

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number 09/497071	Filed 2/2/2000
on _____ Signature_____	First Named Inventor Hoffberg-Borghesani	
Typed or printed name _____	Art Unit 2623	Examiner Jason P. Salce

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
　　　Note: No more than five (5) pages may be provided.

I am the

[X] applicant/inventor.

[ ] assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

[X] attorney or agent of record.   33,511
Registration number _____

[ ] attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____
Signature

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Typed or printed name

914-949-3100
Telephone number

12/11/07
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

[ ] *Total of _____ forms are submitted.

<u>PREAPPEAL CONFERENCE BRIEF</u>

Claim 177 is rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite (for the first time as a Final rejection, offering no opportunity to correct the alleged indefiniteness). The Examiner has interpreted the claim to mean: "data representing content characteristics, a member of the set of available media programs and the data representing content characteristics of previously selected media". This interpretation is suggested by the Examiner to be unsupported by the Specification, and disparate with the other independent claims in the application. In fact, the correct interpretation requires the word "of" to replace the comma interpreted to exist by the Examiner, in a manner presented, for example, in claim 155, which provides the step of "automatically performing a search **of** said available media for a correspondence to data representing content characteristics of the previously selected media". It is error to interpret a claim in a manner inconsistent with the specification when an alternate is readily available which is consistent. A claim may be considered valid under 35 U.S.C. § 112, even though it contains a typographical error, of a person of ordinary skill (and creativity) in the art would have understood its scope.

Claims 166-168, 177, 187, and 190-193 are rejected under 35 U.S.C. § 112, as allegedly failing to comply with the written description requirement. Support cited herein is for each claim is intended to be exemplary, and not exclusive, and therefore the citations provided below are not intended to limit the scope of protection sought or otherwise interpret the claims.

Claim 166 provides that the at least one memory further stores information regarding at least two humans, wherein said signal is dependent on a defined set of humans. This limitation is clearly supported in the specification at, for example at Page 117, lines 9-15; Page 138, line 15-Page 139, line 2; and Example 27, page 203 et seq.

Claim 167 provides a system wherein a presentation of media is restricted in dependence on a financial transaction. Claim 190 provides a method comprising the step of restricting a use of available media in dependence on a financial transaction. Claim 191 provides a method comprising the step of financially accounting in dependence on the output. These are supported, for example, in Example 31, page 213, et seq.

Claim 168 provides a system for selecting media items, comprising "an accounting database for recording commercial transaction data relating to selections received." See, generally, pages 75-81 for support. This language is believed particularly supported on Page 73,

lines 6-17 ("The present invention also provides a mechanism for copyright holders or other proprietary interests to be protected, by limiting access to information be encryption or selective encryption, and providing an accounting system for determining and tracking license or broadcast fees.") See also Page 75, line 7-Page 76, line 2; Page 87, lines 6-24; Page 103, lines 11-15; Page 146, lines 26-Page 147, line 7; Example 31, especially Page 214, lines 9-18.

Claim 177 largely to other independent claims which were not rejected. However, all or portions of claim 177 are supported at least at Fig. 21, e.g., ref. 2107, Fig. 24, e.g., ref. 2406, Fig. 26, e.g., ref. 2607, 2608, Fig. 31; Page 69, lines 15-23; Page 86, lines 1-10; Page 71, line 25-Page 72, line 5; Page 92, lines 3-9; Page 93, lines 10-26; Page 102, lines 19-26; and Page 107, line 7-Page 108, line 2.

Claim 187 provides a method wherein said output comprises a displayed list of hypertext entries representing available media, further comprising the step of receiving a selection of one of the hypertext entries. This is supported, for example, at Page 63, lines 6-26; Page 88, lines 9-12; and Page 127, lines 27-Page 128, line 5.

Claim 192 provides a method comprising the step of delivering an advertisement in dependence on characteristics of media previously selected by the user. Claim 193 provides a method comprising the step of accounting for delivery of an advertisement. These claims are believed supported in the specification at Page 44, line 33-Page 47, line 13; Page 74, line 20-Page 75, line 25; Page 83, line 29-Page 84, line 28; Page 85, lines 4-13; Page 86, lines 1-25; and Page 87, lines 16-24.

Claims 155-156 and 160-161 are rejected under 35 U.S.C. 35 U.S.C. § 102(e) as being anticipated by Vogel, US 5,253,066. The independent claims only will be discussed, as being dispositive of the entire application at this stage. The examiner states that Vogel discloses storing data describing available media. For example, Vogel appears to describe receiving a television schedule. Col. 3, line 51. The examiner takes the position that Vogel discloses storing the "real time data" which includes the immediately-past selected program by the viewer. Col. 3, lines 59-61. However, it is noted that Vogel itself refers to this as the "channel currently selected", Col. 6, lines 40-41, and therefore, the reference makes clear that this is not "prior", but current. Therefore, while this information may be stored while the channel selector is in a given state, there is no teaching or suggestion that it persists thereafter, and thus Vogel does not teach "storing data representing previously selected media". Vogel indeed does disclose listing

programs set for future recording, however, this is distinguished from the claimed subject matter.

The "automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media, wherein said data representing content characteristics are not received as an input from a human user" step of claim 155 is allegedly met by Vogel at Col. 5, lines 13-20. The Examiner states that the available media are part of the real time data (Col. 3, lines 59-66). In this interpretation, the electronic program guide (EPG) data is not itself input by the user, and comprises the content characteristics of the available media. Since, according to this interpretation, the EPG is filtered based (merely) on the selected channel, a "search" is performed. It is respectfully submitted that no search is performed by Vogel; the channel identifier of the selected channel is used as an index to reference a single listing in the EPG, and no search of the contents of the EPG is performed, as this term is commonly understood. Thus, for example, if a search were performed, then two available media with identical "data representing content characteristics" would both be returned. Note that the channel identifier is not a content characteristic of the media, it represents delivery information. That is, a letter delivered to one street address does not have a different content characteristic than an identical letter delivered to a different address. It is noted that the entries made by the user for future recording are also not automatically searched for a correspondence, since the EPG entry itself is the basis for the selection. Likewise, it is noted that the word "characteristics" is pluralized. Vogel et al. match a single identifier of the currently selected channel to determine the correct EPG listing. The word "content", for example, means "message: what a communication that is about something is about."

Finally, the examiner states that the claim 155 step of "automatically issuing a notification of available media having characteristics corresponding to, but not identical to previously selected media" is met by Vogel's disclosure in Fig. 4 of "not only ... the previously selected media and available media (recorded programs) corresponding to, but not identical to (different classifications, times and channels)) previously selected media (see again Col. 5, lines 13-20 and Fig. 3 for notifying the user (by displaying the program menu) where notification contains a classification for each program)." It is initially noted that the examiner uses two different meanings for "available media": the first, in the "storing data" step, in which the EPG data is stated to meet this element, and second in the "automatically issuing" step wherein the "recorded programs". Even assuming that the "available media" could encompass both

simultaneously, the reference still fails to meet the claim language. The claim requires a correspondence involving "characteristics" (plural). Vogel indeed displays human editorial input characteristics of the available media, as shown in Fig. 2, including tile and censorship classification. It does not, however, teach or suggest that any notification is issued for available media having characteristics in any way corresponding to the previously selected media. Fig. 4, for example, shows status, and the right-hand column appears to represent shows scheduled for recording. Claim 155 specifically requires that the automatically issued notification exclude identical "previously selected media". Nowhere does Vogel teach or suggest any such exclusion, nor does it teach or suggest any means for determining identity if media. It is further noted that the media is defined by its characteristics, and not its time and channel slot, and Vogel does not preclude representation of the same content. The filtering of Vogel (based e.g., on censorship classification) is in no way dependent on the characteristics of the prior media selection by the user, and therefore has no way of determining correspondence. It is therefore respectfully submitted that claim 155 is distinguished in a number of ways from Vogel et al., and that the rejection should be withdrawn. Claims 156 and 161 are likewise distinguished.

With respect to claim 162, Vogel does not teach or suggest "automatically performing a search of said available media for a correspondence to data representing content characteristics of the previously selected media, wherein said data representing content characteristics are not received as an input from a human user", and it is believed that at least the processor component is likewise distinguished. The processor produc[es] a signal dependent on a degree of said correspondence. Vogel does not teach or suggest any signal that is dependent on a <u>degree</u> of a <u>correspondence</u>. Vogel teaches if at all, that an EPG listing matching a currently selected program is selected. The degree of correspondence requires something more than a mere binary determination of match or no-match. The word "degree" means in this context, for example, "a position on a scale of intensity or amount or quality; a specific identifiable position in a continuum or series or especially in a process."

Claim 177 is similarly rejected as claims 155, 162 and 168, and in general, the same arguments rebutting the rejection of claims 155 And 162 are applicable. It is noted that claim 177 relates to "content" characteristics. The EPG of Vogel fails to support the distinctions between "characteristics" and "content characteristics", which require that the characteristics relate to content, and not the "container" in which it is carried. Thus, neither the title nor

censorship classification of a program represents a characteristic of its content. A _degree_ of correspondence between data representing content characteristics of a member of the set of available media programs and the data representing content characteristics of previously selected media is automatically determined, and an identification of at least one member of the set of available media programs having content characteristics corresponding to content characteristics of previously selected media is output in dependence on the automatically determined correspondence. Vogel does not teach or suggest determining a correspondence between the content characteristics of at least one member of the set of available media programs and content characteristics of previously selected media in dependence on the automatically determined correspondence.

In claim 182, the characteristics are "content-dependent characteristics", which even more strongly reinforce the distinctions drawn above with respect to Vogel. The _degree_ or correspondence is determined. Other distinctions are adopted as appropriate from the other independent claims

Claim 183 employs "content characteristics", as previously distinguished, and particularly recites that the relation between the available media and media previously selected by the respective user is automatically determined based on a respective plurality of content characteristics. This claim therefore further reinforces the requirement for a multiple characteristics to be related, as previously discussed.

Claims 168-173 and 192-193 are rejected under 35 U.S.C. § 103 as being obvious over Vogel in view of Wachob (US 5,155,591). The examiner asserts that Vogel presents a "recommendation". No such disclosure is believed to be present. Vogel, at best filters or matches based on broad categories, and does not suggest or advise of anything. Likewise, Vogel does not teach or suggest that any such "recommendation" "based on a degree of correspondence of said selection and content characteristics of available media items input independently of a human user." It is particularly noted that the output of Vogel with respect to a censored set of programs is an express limitation and mandate made by the user, and therefore is fully binding, and not optional, as would be a recommendation. Nothing in Wachob remedies this deficiency. Indeed, Wachob apparently filters commercials based on user demographic characteristics, and not based on user selections and/or content characteristics.

It is respectfully submitted that the rejections should be reversed.